

REMARKS

Claims 1, 4 to 6, 8, and 11 to 30 remain pending. Claims 4, 5, and 14 to 30 remain withdrawn. Claims 2, 3, 7, 10, and 31 have been cancelled. Claim 32 has been added.

Claims 6 to 9 and newly-recited claims 1, 2, and 10 to 13 have been rejected under 35 U.S.C. 112, first paragraph, for lack of enablement. The Action admits the specification is enabling for a topical lightening agent having a melanin synthesis-regulating agent, such as coconut water, and a melanin uptake-inhibiting agent of an aqueous extract of perilla. The Action stated that the enablement for the lightening agent and uptake-inhibiting agent did not enable an effective amount of any melanin synthesis-regulating agent or any melanin uptake-inhibiting agent. The Action stated that the specification did not provide sufficient specificity regarding other agents or effective amounts thereof. The Action also stated that the specification did not enable plant extracts other than aqueous extracts. The Action stated that extracts have unpredictable and varying effects.

The rejection of claims 6 and 8 under 35 U.S.C. 112, first paragraph, for lack of enablement is overcome in view of the amendments to claim 6. Independent claim 6 requires a melanin synthesis-regulating agent selected from a list of species and that the melanin uptake inhibiting agent also be selected from a list of species. The list of species for the melanin synthesis-regulating agent is set forth in the specification. Also, claim 6 requires the melanin uptake inhibiting agent have an aqueous

extract of perilla. The amendment directed to an aqueous extract of perilla has been effected to further prosecution in the instant application and is not to be construed as limiting or defining with respect to the scope or meaning of the term perilla extract in any subsequent or related application(s). Further, claim 6 requires a particular amount of topical lightening agent.

The rejection of claims 1 and 13 under 35 U.S.C. 112, first paragraph, for lack of enablement is overcome in view of the amendments to claim 1. Independent claim 1 requires a melanin synthesis-regulating agent selected from a list of species. The list of species is set forth in the specification.

The rejection of claims 2, 3, 7, 9, and 10 under 35 U.S.C. 112, first paragraph, for lack of enablement is moot since they have been cancelled.

Claims 1, 2, 6 to 13, and 31 have been rejected under 35 U.S.C. 112, second paragraph, for failure to comply with the written description requirement (page 3, lines 5 to 9 of the Action). The Action stated that the claims had subject matter not described in the specification.

The rejection of claims 1, 6, 8, and 11 to 13 is not well taken under 35 U.S.C. 112, second paragraph, because the rejection did not provide an explanation as to what claimed subject matter failed to meet the written description requirement. The Action stated "The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that

the inventor(s), at the time the application was filed, had possession of the invention." No other information was provided in the Action. Any attempt to discern the identity of the objected-to claim language would require unreasonable speculation on the part of Applicants.

The rejection of claims 2, 7, 9, 10, and 31 under 35 U.S.C. 112, second paragraph, is moot since they have been cancelled.

Claim 31 has been rejected under 35 U.S.C. 112, second paragraph, for failure to comply with the written description requirement. The Action stated that claim 31 referred to a composition instead of a method as in claim 7, the claim from which it depends.

The rejection of claim 31 under 35 U.S.C. 112, second paragraph, is moot since it has been cancelled.

Claims 1 to 3 and 13 have been rejected under 35 U.S.C. 102(b) as anticipated by International Product Alert. The Action stated that the claim language "wherein the composition is applied to the skin" refers to an intended use and does not hold any patentable weight.

The rejection of claims 1 and 13 under 35 U.S.C. 102(b) over the International Product Alert (IPA) is overcome in view of the amendments to claim 1. Independent claim 1 requires a vehicle selected from a list. In contrast, the beverage of the IPA does not have any of the selected vehicles. Thus, claims 1 and 13 are novel in view of the IPA. Dependent claim 13 further requires

the claimed composition be in a product form selected from a list. The IPA is a beverage, which is not present in the claimed list of product forms. Thus, claim 13 is further novel in view of the IPA.

The rejection of claims 2 and 3 under 35 U.S.C. 102(b) over the International Product Alert is moot since they have been cancelled.

Claims 1 to 3 and 10 to 13 have been rejected under 35 U.S.C. 103(a) as being unpatentable over the IPA. The Action stated that the intended use on the skin does not hold any patentable weight.

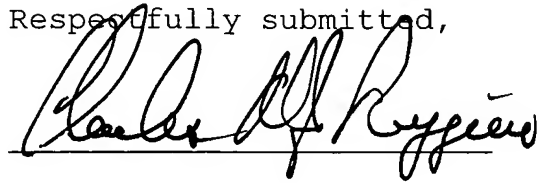
The rejection of claims 1 and 10 to 13 under 35 U.S.C. 103(a) over the IPA is overcome in view of the amendments to independent claim 1. Independent claim 1 requires a vehicle selected from a list. In contrast, the beverage of the IPA does not have any of the selected vehicles. There is no suggestion in the disclosure of the IPA that the disclosed beverage would have any such vehicles. Thus, claims 1 and 13 are nonobvious in view of the IPA. Dependent claims 11 and 12 require the topical lightening agent be present in particular amounts. In contrast, the IPA does not disclose or suggest coconut juice or any other ingredient in any particular amount. Thus, claims 11 and 12 are further nonobvious in view of the IPA. Dependent claim 13 further requires the claimed composition be in a product form selected from a list. The IPA discloses a beverage, which is not present in the claimed list of product forms. Thus, claim 13 is further nonobvious in view of the IPA.

The rejection of claims 2, 3, and 10 under 35 U.S.C. 103(a) over the IPA is moot since they have been cancelled.

Reconsideration of claims 1, 6, 8, and 11 to 13 is deemed warranted in view of the foregoing, and allowance of said claims and new claim 32 is earnestly solicited.

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Respectfully submitted,

A handwritten signature in black ink, appearing to read "Charles N. J. Ruggiero", written over a horizontal line.

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